REMARKS/ARGUMENTS

This amendment is respectfully submitted in response to the Office Action dated April 28, 2006. **Applicants undersigned representative hereby formally requests an interview to discuss this matter if the Examiner intends to maintain any of the outstanding rejections after consideration of this amendment.**

I. Introduction

New claims 28-31 have been added. Claims 1, 9 and 19 have been amended. Accordingly, claims 1-13 and 19-29 are now pending.

Support for new claims 28 and 29 can be found on page 26 of the application on lines 11-26 and elsewhere in the application. **The subject matter of new claims 28-29 is not taught, disclosed or suggested by the applied references.** Support for new claims 30 and 31 can be found on application pages 18 and 20 and elsewhere in the application.

In the Office Action the Examiner rejected claims 1-5, 7, 19-20, 24, 26, and 27 under 35 USC §103(a) as being unpatentable over Kajiya et al. (U.S. Patent No. 5,448,626) in view of Naylor et al. (US 6,625,642). In addition, the Examiner rejected claims 6, 8-13, 21-23 and 25 under 35 U.S.C. §103(a) as being unpatentable over the Kajiya et al. patent in view of the Naylor patent as applied to claims 1-5, 7, 19-20, 24, 26 and 27 in view of U.S. Patent No. 5,465,295 to Furman.

.As will be discussed below none of the pending claims are anticipated or rendered obvious by the applied references.

II. Brief Discussion of the Invention

Applicants suggest that the Examiner review pages 27 and 28 for a discussion of some of the novel and beneficial features of the invention.

The present invention provides fax and voice call forwarding capabilities which are more convenient and useful than conventional call forwarding services. In accordance with various embodiments of the invention, calls are checked, e.g., after being answered in some embodiments, to determine if the call is a voice call or a fax call. Thus, the invention allows for fax and voice calls to be treated differently. The service subscriber to which a telephone number corresponds has control over the voice and fax forwarding features and can update the information via the Internet or via a telephone call to a peripheral device.

The system of the present invention to supports multiple modes of delivery of a facsimile thereby allowing the same fax to be delivered by multiple methods, e.g., by a telephone call and by E-mail. In this way, a service subscriber can receive a fax via E-mail, e.g., while traveling, while the fax can also be forwarded to a telephone number specified by the subscriber, e.g., to a hotel fax machine or the user's regular fax machine. In such a case, the subscriber will receive multiple copies of the fax thereby providing the subscriber the ability to read the fax, e.g., in E-mail form, when traveling while still allowing the subscriber to obtain a hard copy from a conventional fax machine thereby avoiding the need for the user to print the E-mail which may be inconvenient while traveling.

In addition to allowing a subscriber to receive a fax by both E-mail in addition to a conventional fax machine, in various embodiments the fax by E-mail forwarding and fax by telephone forwarding features are controlled by separate status indicators included in a subscriber record. In this manner, a user can control the voice call forwarding, fax by telephone forwarding and fax by E-mail forwarding separately. The status indicators are, in some embodiments, in addition to information indicating

a telephone number or E-mail address to which voice calls or faxes should be sent. **The use of different indicators for different forwarding options enables the service subscriber to enable/disable each forwarding features independently for a high degree of flexibility**. For example, depending on where a user is traveling E-mail access may be limited to a low speed connection at a particular location. In such a case the user may want to disable the E-mail forwarding feature to avoid clogging the user's E-mail with large files while at the location which supports only a low speed E-mail connection. While at such a location the user may want to have the faxes forwarded to a hotel's fax machine without receiving E-mail copies while at other times the user may wish to receive the facsimiles by both E-mail and telephone.

The applied references do not teach, disclose, or suggest a system such as that disclosed in the patent where forwarding of faxes via E-mail and telephone can be used together, e.g., in parallel, but **controlled independently according to the user's needs at a particular time**. Furthermore, they fail to teach, disclose or suggest such fax forwarding methods in combination with voice call forwarding which, in accordance with the invention, can be controlled to forward voice calls **to a different telephone number, e.g., a telephone number different from that which the call was originally directed and different from that to which fax calls are forwarded**.

III. The Pending Claims Are Patentable

In rejecting claims 1-5, 7, 19, 20, 24, 26, and 27 the Examiner states:

> Column 4, line 1- column 5, line 10 of Kajiya plainly teaches the claimed fax forwarding communications method of above claims. The stored voice telephone number and fax telephone number are clearly depicted in Fig. 2.
>
> Kajiya is silent with respect to the feature of parallel fax delivery to an E-mail address and a facsimile device/telephone number. However, Naylor plainly teaches such a feature; refer to FIG. 6; column 9, line 50 - column 10, line 13 and column 11, line 46- column 12, line 4 of Naylor. Naylor also teaches the claimed status indicators of claim 24 (reads on the destination identifiers and the indicators of Fig. 6). Therefore, it would have been obvious even to one of of ordinary skill in the art at the time of the

invention to modify the method of Kajiya to forward the fax calls to an email address and a facsimile device/telephone number as taught by Naylor in order to provide the subscribers a more convenient manner of receiving fax documents via multiple media options. (See Office Action)

Applicant's representative notes that while the Examiner cites portions of the applied references in support of the rejection, the rejection unfortunately fails to clearly match or map the elements of the references to the individual steps/elements of the claims. Accordingly, while the references may discuss certain elements, when considered for as a whole, the references do not teach, disclose, suggest or in any way render obvious the particular combination of elements/steps recited in the pending claims. This is apparent when the elements of the references, whether considered alone or in combination, are carefully compared to the claims.

1. **Discussion of the Applied References:**

A. **The Kajiya et al. patent**

The Kajiya et al. patent describes a facsimile mail system. In the Kajiya et al. patent voice and facsimile calls may be sent to the same telephone number with a discriminator or judgment device being used to make a judgment as to whether a received telephone signal is a voice signal to **be connected to a particular telephone or a facsimile signal to be connected to a particular facsimile device**. (See col. 3, lines 35-42). In the case where the discriminator indicates a voice telephone signal, **the call is connected to the telephone number** having the destination number informed by the telephone facsimile discriminator (See col. 4, lines 24-29) **which is the original destination number** (see col. 4, line 19). If the call goes unanswered, the call is then automatically transferred to a voice mail accumulator. (See col. 4, lines 29-32). In the embodiment described in col. 4, when the discrimination signal indicates a facsimile signal the PBX connects the line connected to the discriminator **to a facsimile mail accumulator**. (See col. 4, lines 41-44). Notably, delivery is not

immediately to the intended recipient as in the case of a direct forwarding operation and further action appears required for the facsimile mail accumulator to actually deliver the facsimile. (See, e.g., Col. 5, lines 11 -29) The party to whom the fax was directed is informed of the incoming fax but action must then be taken for actual delivery to occur.

Thus, **it is should be appreciated that Kajiya et al. does not describe a system where a subscriber is setting voice calls to be forwarded to a telephone number different from the one to which the call is originally directed but rather a system where detected voice calls are sent to the called number and if they go unanswered are sent to a voice mail accumulator. In addition, faxes are not forwarded directly to the subscriber but are rather sent to an accumulator where some outside trigger then appears necessary to result in actual delivery,** at least in the embodiments described in col. 5.

A review of Fig. 2 cited by the Examiner supports Applicants' interpretation of the Kajiya et al. reference. Note that the Telephone number for contact (column 2 of Fig. 2) is shown as being the same in all cases as the TELEPHONE/FAX No. shown in the first column of Fig. 2. Thus, **Kajiya et al.** shows and teaches directing voice calls to the called number while facsimile calls may be redirected to a different number (see col. 3 of Fig. 2 where the fax number differs from the called number).

Applicants are unaware of any portion of **Kajiya et al.** which discusses an individual to which the TELEPHONE/FAX No. corresponds configuring the information shown in Fig. 2. Applicants respectfully submit that such information may have been configured by a system administrator and **the Examiner has failed to show anything that establishes that the individual to whom the number corresponds is responsible for configuring the information shown in Fig. 2.**

B. The Naylor et al. patent

The Naylor et al. system relies on the use of **specialized data, which is based on data entered into the sending fax device by the user and is transferred from this fax device to the server in the fax transmission.** (See col. 2, lines 33-35) The specialized data is then processed by the server which deciphers it and then uses it to determine how to forward the fax by email or fax transmission. (See Summary col. 2, lines 25-59)

Thus, the Naylor et al. patent describes a system **where the sender's fax machine includes specialized data used to determine how to deliver a fax and to whom the fax should be directed with the fax being sent initially NOT to the telephone number of the intended recipient but rather to a server device.**

B. The Furman Patent

The Examiner recognizes that "Naylor is not implemented in a public AIN." but cites the Furman patent as teaching that "fax call forwarding methods can be implemented in a public AIN.

Applicants submit that even if, assuming for the sake of argument that the Furman patent describes "fax call forwarding" in "a public AIN". This does not anticipate or render obvious in any way the particular methods recited in the pending claims since the Furman patent fails to teach, disclose or suggest the recited implementation. Simply because faxes can be forwarded in an AIN network does NOT render obvious the claimed methods or embodiments which are directed to particular ways of providing fax and call forwarding implementations using AIN capabilities. Applicants respectfully submit that one fax forwarding approach does not render obvious all fax forwarding methods. The Examiner has failed to address the specifics with regard to the recited methods.

2. Discussion of The Claims

A. General Reason All the Pending Claims Are Patentable

Applicants respectfully submit that the Naylor patent is directed to a system which **requires that the sender's fax machine include specialized data** (See Naylor summary col. 2, lines 33-35) which is then used to control delivery of the facsimile message being sent. It is submitted that since such **specialized data** is NOT present in a facsimile call that is sent in the Kajiya et al. patent one of ordinary skill in the art would not be motivated to combine the fax sending method described in Naylor with that of Kajiya. Since the specialized data was missing the Naylor fax forwarding method would not work properly in the Kajiya et al. system. Furthermore, to require the sender to include such specialized data would place an undersirable constraint on the senders of facsimiles in the Kajiya et al. system.

Accordingly, the Examiner proposed combination of the Kajiya et al. patent and Naylor patent would not only fail to result in the claimed invention but would not be obvious to one of ordinary skill in the art because of the technical problems with the combination in terms of operability and undesirable constraints being placed on the sender's device when a sender tries to send a fax to an intended recipient.

In view of the above remarks, it is respectfully submitted that the rejection of all the pending claims should be withdrawn since the Examiner proposed combination of references would not be obvious to one of ordinary skill in the art due to the technical problems with combining the references.

B. Claims 1-7 and 27 are Patentable

Claim 1 is patentable because the applied references fail to teach, disclose or suggest the claimed method and particularly the features indicated in bold below.

Claim 1 is patentable because, as amended, it recites:

> A communications method, comprising the steps of:
> **providing a service subscriber an opportunity to separately enable and disable forwarding of fax and voice telephone calls directed to a first telephone number corresponding to the service subscriber;**
> detecting a first telephone call to a the first telephone number corresponding to a the service subscriber;
> determining if the first telephone call is a fax or voice telephone call;
> and
> if the first telephone call is determined to be a fax telephone call, and fax forwarding has been enabled by said subscriber, performing, i) a fax delivery by E-mail operation and ii) a fax delivery by telephone operation **when a customer record corresponding to said subscriber includes information indicating that a received fax directed to said subscriber is to be forwarded by both telephone and E-mail** thereby resulting in delivery of a facsimile received from said first telephone call by both an E-mail message and by a telephone call thereby providing delivery of the facsimile to multiple devices.

C. **Claims 8-13 are Patentable**

As discussed above, the Examiner proposed combination of the Kajiya et al. and Naylor patents would not have been obvious to one of ordinary skill in the art. Further more, even if combined with the Furman patent the combination would not have resulted in the particular combination of steps recited in claims 8-13. If the Examiner is to maintain the rejection of the claims, the Examiner bears the burden of showing that the particular combination of steps would have been obvious. The Examiner has failed to meet this burden since the Examiner has not shown where the individual claimed steps can be found in the applied references.

If the Examiner maintains the rejections, it is requested that the Examiner explain the basis of the rejection further and address the elements of the dependent claims individually identifying where in the applied references the claimed features can allegedly be found.

For example, please indicate who the Examiner considers to be the called party recited in claim 9? If it is the recipient of the fax, how does the Examiner assert this corresponds/matches the Naylor patent where the fax sender is the one in control of whether the fax will be sent by the server by E-mail or facsimile?

D. Claims 19-23 Are Patentable

Claim 19 is patentable for the reasons discussed above but also for the additional reasons that it recites the subject matter indicated in bold below.:

> A communications method, the method comprising the steps of:
> operating a telephone switch to detect a call **to a telephone number corresponding to a call forwarding service subscriber;**
> connecting the telephone call to a peripheral device coupled to the telephone switch;
> operating said peripheral device to:
> i. answer said call;
> ii. determine if the answered call is a fax telephone call or a non-fax call;
> iii. if it is determined that the answered telephone call is a fax telephone call, **connect the call by a telephone line to a facsimile device corresponding to the call forwarding service subscriber *while monitoring the telephone call to receive a facsimile message* delivered to the facsimile device**; and
> iv. send an E-mail message including said received facsimile message to thereby deliver said facsimile by an E-mail device corresponding to said subscriber in addition to delivery to said facsimile device corresponding to said subscriber.

Applicants respectfully submit that the Naylor patent teaches away from **monitoring a telephone call to receive a facsimile message delivered to a facsimile device after the call has been connected to the facsimile device** to thereby receive the facsimile being communicated in the call, e.g., for forwarding by E-mail. Note that in the Naylor system the receiving server receives the fax transmission and disconnects **before the server sends the facsimile to a facsimile device corresponding to the intended recipient.** (See Fig. 4 of the Naylor patent, step 404 "Server receives fax transmission and disconnects.")

Accordingly, claims 19-23 are patentable.

E. Claims 24-26 Are Patentable

Claim 24 is patentable for the reasons discussed above but also because it recites the subject matter indicated in bold below.

> A fax forwarding method, the method comprising:
>
> **for each of a plurality of fax forwarding service subscribers, creating a subscriber record including**:
>
> at least one telephone number corresponding to a telephone line **on which the forwarding service subscriber may receive a fax call;**
>
> **fax forwarding by E-mail status information indicating whether faxes are to be forwarded by E-mail;**
>
> **fax forwarding by telephone status information indicating if faxes are to be forwarded by telephone; and**
>
> an E-mail address to be used to forward a fax received by answering a call directed to said at least one telephone number;
>
> monitoring a plurality of said telephone lines on which fax forwarding service subscribers may receive fax calls; and
>
> **in response to receiving a call on one of said monitored lines**:
>
> determining if said received call is a fax call or a non-fax call;
>
> if the received call is determined to be a fax call and the fax forwarding by E-mail status information indicates faxes are to be forwarded by E-mail for the monitored line on which the call was received, determining from the subscriber record corresponding to the telephone line on which the fax call is received, an E-mail address to be used for forwarding a fax received on said telephone line; and forwarding by E-mail, using the determined E-mail address, a fax received on said telephone line; and
>
> if the call is determined to be a fax call and the fax forwarding by telephone status information indicates faxes are to be forwarded by telephone for the monitored line on

> which the call was received, forwarding said fax call to a telephone number indicated by the subscriber record corresponding to the telephone line on which the call was received.

Note that the fax forwarding service subscribers are the parties to which faxes may be sent. Thus they are the recipients of the faxes not the sender of the fax which is being forwarded. Accordingly, it is the fax recipient which controls whether it will be sent by E-mail or telephone. In the Naylor patent the original sender of the fax is the party that controls the fax destination and delivery method through the use of "special information" originally sent with the fax. (See summary col. 2, lines 30-45.) This differs from claim 24.

F. New Claims 28-31 Are Patentable

The new claims have been added to cover features which not disclosed or suggested by the applied references. These claims are patentable for the same reasons as claim 1 but also because of the features which they recite.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, Applicant requests that the Examiner pass this application to issue.

If there are any outstanding issues which need to be resolved to place the application in condition for allowance the Examiner is invited to contact Applicant's undersigned representative by phone to discuss and hopefully resolve said issues. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136 is hereby made, the fee for which should be charged to Patent Office deposit account number 50-1049.

Respectfully submitted,

October 30, 2006

Michael P. Straub, Attorney
Reg. No. 36,941
Tel.: (732) 542-9070

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

Michael P. Straub
Type or print name of person signing certification

Signature

October 30, 2006
Date